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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,516	12/20/2001	Gordon Kessler	Kess-01	4502

7590
Gordon Kessler
59 Fox Den Road
Mt. Kisco, NY 10549

09/30/2005

EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

10/028,516

Applicant(s)

KESSLER, GORDON

Examiner

J. Bret Dennison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 10/028,516 received on 07 July 2005.
2. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman et al. (U.S. Patent Application Publication 2003/0063407).

3. Regarding claims 1, 16, and 19, Zimmerman disclosed a method for downloading audio data (Zimmerman, paragraph 28) comprising the steps of:

providing user preference data indicating one or more topics of interest to a user, and a relative ranking between these topics (Zimmerman, paragraphs 35 and 58, Zimmerman disclosed a user setting preference data including priority);

providing user designated time span data indicative of a desired time for listening to an audio program (Zimmerman, paragraph 37 and Abstract, Zimmerman disclosed the user being able to input the amount of time the user has to view/listen to audio-video segments);

forwarding said user preference data and said user designated time span data to a storage device (Zimmerman, paragraph 34, Zimmerman disclosed a hard disk drive to include any mass storage device. Zimmerman also disclosed external mass storage devices the video playback device may access and control via a network connection);

retrieving a plurality of audio data corresponding to said user preference data (Zimmerman, paragraph 35);

determining a length of time required to playback said audio data (Zimmerman, paragraph 37);

determining whether said length of time required to playback said audio data is longer than said user designated time span, reducing the length of at least one of said plurality of audio data if it is determined that said length of time required to playback said audio data is longer than said user designated time span and outputting said audio data including said one of said plurality of audio data reduced in length (Zimmerman, paragraphs 35 and 37, Zimmerman disclosed the user setting a threshold for the video/audio segments, and the video playback device determining which segments are above the threshold and plays them based on priority values given by the user. Segments are chosen according to their priority level and a viewer-determined playback time period. Rather than playing the complete content, the playback controller reduces the number of segments based on user priority and the user time span).

Zimmerman did not explicitly state outputting the determined audio data to a portable device.

However, outputting audio/video data to a portable device was well known in the art at the time of the invention, as noted by Applicant (See Specification, Summary of the Invention, first sentence). Since Zimmerman disclosed providing the amount of audio/video data to be played back, based on a threshold, it would have been obvious to one of ordinary skill in the art to including outputting this provided amount of data to a portable device for playback as well in order to play back the proper amount of audio-video data in the limited time frame determined by the user (Zimmerman, see Abstract, page 1, paragraph 4).

Claim 16 includes a method with limitations similar to the limitations of claim 1. Claim 19 includes a base unit with the same functionality as claim 1. Claims 1, 16, and 19 are therefore rejected under the same prior art as being substantially similar to claims.

4. Regarding claims 2 and 7, Zimmerman disclosed wherein the determination of said length of time required to playback said audio data, the determination of whether said length of time required to playback said audio data is longer than said user designated time span, and the reducing the length of at least one of said plurality of audio data are repeated, each time reducing the length of a different one of said plurality of audio data until it is determined that said length of time required to playback said audio data is not longer than said user designated time span (Zimmerman, paragraphs 35-37, Zimmerman teaches repeatedly choosing segments based on the user preferences).

5. Regarding claim 3, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said audio data comprises news programs (Zimmerman, paragraph 64).

6.

7. Regarding claim 4, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein at least one of said plurality of said audio data comprises an advertisement (Zimmerman, paragraph 44).

8. Regarding claims 5, 8, 9, and 10, Zimmerman disclosed the limitations, substantially as claimed, as described in claims 1 and 7, including wherein the length of said at least one of said audio data is reduced by substituting a summary audio data for said audio data (Zimmerman, paragraph 44, Zimmerman disclosed the summary of video/audio data can be any segment of any content, for example parts of a show).

9. Regarding claim 6, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the length of said at least one of said audio data is reduced by substituting a title audio data for said audio data (Zimmerman, paragraph 44).

10. Regarding claim 11, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said relative ranking between topics

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includes placing the topics in a continuous order from most to least, or least to most desirable (Zimmerman, paragraph 58, Zimmerman teaches the viewer being able to modify priority values of segments to personalize them, wherein priority qualifies as order).

11. Regarding claim 12, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said relative ranking between topics includes placing each of the topics in one of a plurality of categories, the categories indicating a relative preference between the topics contained therein (Zimmerman, paragraph 60, Zimmerman teaches segment priority hierarchies).

12. Regarding claims 13-15, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said relative ranking between topics includes indicating whether an audio program corresponding to each topic is eligible to be reduced in length (Zimmerman, paragraph 66, Zimmerman disclosed priority hierarchy files containing data telling video playback device which segments to play back, depending on the amount of playback time specified by the user).

13. Regarding claim 17, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 16, including wherein said plurality of audio data is selected in accordance with one or more user preferences (Zimmerman, paragraph 58).

14. Regarding claim 18, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 16, including wherein said designated time span is designated by a user (Zimmerman, paragraph 37).

15. Regarding claim 20, Zimmerman disclosed the limitations, substantially as claimed, as described in claim 19, including wherein said received audio data is output to a remote device (Zimmerman, paragraph 28).

Response to Amendment

Applicant's arguments and amendments filed on 07 July 2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, which will require further search and consideration*) to the claims which significantly affected the scope thereof.

Applicant's arguments with respect to claims 1, 5, 16, and 19 have been fully considered but they are not persuasive.

Applicant's first argument includes the failure of previously applied art to expressly disclose the teachings of making a "determination of data to be replayed" [see Applicant's Response, page 6]. It is evident from the mappings found in the above rejection that Zimmerman disclosed an improved playback device that chooses

segments of audio/video data to be provided to the user “without user intervention” (Zimmerman, page 1, paragraph 4).

Applicant’s second argument includes the failure of previously applied art to expressly disclose the teachings of storing this data to a “portable recording medium” [see Applicant’s Response, page 6]. However, Applicant states that outputting audio/video data to a portable device was well known in the art at the time of the invention, as noted by Applicant (See Specification, Summary of the Invention, first sentence). Since Zimmerman determines the amount of audio data based on the threshold as well as provides this data, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate transferring this data to a portable device.

Applicant argues that “the present invention reduces the time allotted for various played back data rather than deleting various segments” and “rather than reducing playback time by eliminating some of the data to be played back as in Zimmerman, the claimed invention substitutes a different audio program covering the same material” [see Applicant’s Response, page 6]. Claim 1 does not disclose, “substituting a different audio program”. Claim 5 as noted in Applicant’s arguments discloses, “wherein the length of said at least one of said audio data is reduced by substituting a summary audio data for said audio data”. Zimmerman disclosed providing only the higher priority segments of data (Zimmerman, pages 3-4, paragraph 4). This means that the system of Zimmerman does in fact only provide a summary of the original data, because it is not providing the complete original data. This summary is substituted for the original

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data, because the complete original data is not provided. Only the summary is provided in order to provide the exact amount of data according to the amount of time indicated by the user. By Zimmerman cutting out the lesser priority segments, Zimmerman is providing a summary of the most important parts of the show.

Applicant's arguments further state that, "While it is possible to remove portion of the show for playback, it would be silly to suggest that a summary of the program be provided". Removing a portion of the show for playback means only providing a portion of the show for playback, hence a summary. Claim 5 states substituting a summary. Therefore, silly or not, it is irrelevant.

Applicant also states, "the present invention allows for the modification of the actual stories to be presented". Even though this is not found in the independent claims, Zimmerman disclosed removing lower priority segments and providing the summary of higher priority segments. Therefore, Zimmerman disclosed modifying the original data and providing a summary of the original data.

Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that Zimmerman clearly taught the independent claims of the Applicant's claimed invention.

Applicant's arguments with respect to claims 1-20 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Zimmerman as well as other prior arts of records disclosed the claimed invention is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


J. B. D.
Patent Examiner
Art Unit 2143


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100